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| EXAMINER | |
|---|---|
| ROWLAND, STEVE | |
| ART UNIT | PAPER NUMBER |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/547,684 | MITCHELL ET AL. | |
| | Examiner | Art Unit | |
| | STEVE ROWLAND | 3718 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *31 January 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-3,5-15 and 51-64* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-15 and 51-64* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/31/2011 has been entered.

### *Claim Objections*

2. Claims 1 and 51 are objected to because of the following informalities: The phrase "a said partial outcome" should be replaced by --said partial outcome-- in order to correct an apparent typographical error. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1-3, 5-15, and 51-64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *See In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Regarding claims 1 and 51, the specification does not contain adequate support for the limitation of "a plurality of different sub-games, each sub-game drawing symbols from a

different set of sub-game symbols." Applicant has not identified, and Examiner cannot find, support for this subject matter anywhere in the specification. This claim is accordingly rejected under 35 USC § 112 first paragraph for introducing new matter. Claims 2, 3, 5-15, and 52-64 are rejected for incorporating this error from their respective parent claims.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**8. Claims 1-10 and 52-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US 6,132,311) in view of Moody (US 2003/0214097 A1) and Sklansky et al (US 6,511,068 B1) (hereinafter "Sklansky").**

Regarding claim 1, Williams teaches a machine comprising a display (col. 5, lines 1-8), a game controller arranged to control images of symbols displayed on the display (col. 4, lines 59-67), the game controller being arranged to play a game wherein at least one random event is caused to be displayed on the display and, if a predefined winning event occurs, a prize is awarded (Abstract), and a plurality of different sub-games constituting the game displayed on the display with, as an initial display, fewer than a full set of images of each of the sub-games being displayed to show a partial outcome of the game (Fig. 1), the fewer than the full set of images being representative of a determination of an expected value of said partial outcome for each of the sub-games (Fig. 3). It is noted that Williams does not specifically teach wherein the expected value of a first sub-game as derived from the displayed partial outcome of the first sub-game is used to select the displayed fewer than full set of images of the remaining sub-games in the initial display. However, Moody suggests wherein the expected value of a first sub-game as derived from the displayed partial outcome of the first sub-game is used to select the displayed fewer than full set of images of the remaining sub-games in the initial display (¶ [0034]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams and Moody in order to balance payouts with coin-in and thus manage profit margins. Neither Williams nor Moody each sub-game drawing symbols from a different set of sub-game symbols. However, Sklansky teaches each sub-game drawing symbols from a different set of sub-game symbols (col. 13, lines 17-35: *separate decks for each flop*). Hence, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Williams, Moody and Sklansky in order to allow for more winning combinations, thus increasing excitement and interest in the game.

Regarding claims 2 and 52, Williams teaches each sub-game has a plurality of image carrying elements, each of which carries a plurality of images required to be considered in assessing an outcome of the game (col. 7, lines 29-67; col. 8, lines 1-7).

Regarding claims 3 and 53, Williams teaches an initial display of each sub-game where fewer than all of the image carrying elements of the sub-games are displayed to display the partial outcomes of the sub-games (Fig. 2).

Regarding claim 5, Williams teaches a game controller which includes a data storage element in which data relating to expected values for each of the remaining sub-games are stored (20).

Regarding claim 6, Williams teaches data which are stored in the form of look-up tables for each of the sub-games (20).

Regarding claim 7, it is noted that Williams does not specifically teach wherein, once the expected value for the first sub-game has been determined, the game controller accesses the look-up tables for each of the remaining sub-games to ascertain the expected value for each of the remaining sub-games which most closely approximates the expected value for the first sub-game. However, Moody suggests wherein, once the expected value for the first sub-game has been determined, the game controller accesses the look-up tables for each of the remaining sub-games to ascertain the expected value for each of the remaining sub-games which most closely approximates the expected value for the first sub-game (¶ [0034]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams, Moody, and Sklansky in order to balance payouts with coin-in and thus manage profit margins.

Regarding claims 8 and 57, Williams teaches a sub-game which has a feature game associated with it and, if that feature is won, the feature is also played before the game is concluded (col. 8, lines 14-29).

Regarding claims 9 and 58, Williams teaches a feature associated with each sub-game which is a no-cost feature (col. 8, lines 14-29).

Regarding claims 10 and 59, Williams teaches a feature associated with each sub-game which is triggered by the controller independently of the result of a base sub-game preceding the triggered feature (col. 8, lines 14-29).

Regarding claim 51, Williams teaches a method of playing a wagering game on a gaming machine having a display and a controller (col. 4, lines 59-67), comprising arranging the controller to play a game having a plurality of different sub-games wherein at least one random event is caused to be displayed on said display and, if a predefined winning event occurs, a prize is awarded (Abstract), and displaying on said display a partial outcome of said game through fewer than a full set of images of each of said sub-games (Fig. 1). It is noted that Williams does not specifically teach wherein an expected value of said partial outcome of one sub-game as derived from said one of said sub-games is used to select said fewer than a full set of images of said remaining sub-games. However, Moody suggests wherein an expected value of said partial outcome of one sub-game as derived from said one of said sub-games is used to select said fewer than a full set of images of said remaining sub-games game (¶ [0034]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams, Moody, and Sklansky in order to balance payouts with coin-in and thus manage profit margins. Further, neither Williams nor Moody discloses each sub-game drawing symbols from a different set of sub-game symbols. However, Sklansky teaches each sub-game drawing symbols from a different set of sub-game symbols (col. 13, lines 17-35: *separate decks for each flop*). Hence, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Williams, Moody and Sklansky in order to allow for more winning combinations, thus increasing excitement and interest in the game.

Regarding claim 54, it is noted that Williams does not specifically teach storing data relating to expected values for each of the remaining sub-games in a data storage. However, Moody suggests storing data relating to expected values for each of the remaining sub-games in a data storage (¶ [0034]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams, Moody, and Sklansky in order to balance payouts with coin-in and thus manage profit margins.

Regarding claim 55, it is noted that Williams does not specifically teach storing said data of said sub-games in look-up tables. However, Moody suggests storing said data of said sub-games in look-up tables (¶ [0034]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams, Moody, and Sklansky in order to balance payouts with coin-in and thus manage profit margins.

Regarding claim 56, it is noted that Williams does not teach accessing said look-up tables for each of said remaining sub-games to ascertain said expected value for each of the remaining sub- games which most closely approximates the expected value for the first sub-game. However, Moody suggests accessing said look-up tables for each of said remaining sub-games to ascertain said expected value for each of the remaining sub- games which most closely approximates the expected value for the first sub-game (¶ [0034]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams, Moody, and Sklansky in order to balance payouts with coin-in and thus manage profit margins.

**9. Claims 11-14 and 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Moody, Sklansky and Cannon et al (US 2002/0183105 A1) (hereinafter "Cannon").**

Regarding claims 11 and 60, it is noted that neither Williams, Moody, nor Sklansky teaches features associated with the sub-games which differ from one another. However,

Cannon suggests features associated with the sub-games which differ from one another (¶ [0115]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams, Moody, Sklansky and Cannon in order to create diverse and captivating bonus presentations which will potentially induce longer play.

Regarding claims 12 and 61, it is noted that neither Williams, Moody, nor Sklansky teaches a game which has a jackpot bonus feature associated with it. However, Cannon suggests a game which has a jackpot bonus feature associated with it (¶ [0036]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams, Moody, Sklansky and Cannon in order to create an exciting game in which the player competes for a larger than normal payout, thus potentially inducing longer play.

Regarding claims 13 and 62, it is noted that neither Williams, Moody, nor Sklansky teaches a progressive jackpot bonus feature. However, Cannon suggests a progressive jackpot bonus feature (¶ [0078]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams, Moody, Sklansky and Cannon in order to create a captivating game in which the player competes for an ever-increasing payout, thus potentially inducing longer play.

Regarding claims 14 and 63, it is noted that neither Williams, Moody, nor Sklansky teaches a progressive jackpot which comprises at least two jackpot levels being a minor jackpot and a major jackpot. However, Cannon suggests a progressive jackpot which comprises at least two jackpot levels being a minor jackpot and a major jackpot (¶ [0120]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams, Moody, Sklansky and Cannon in order to create a

captivating game in which the player competes for an ever-increasing and variable payout, thus potentially inducing longer play.

**10. Claims 15 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Cannon, Moody, Sklansky, and Baerlocher (US 2003/0054877 A1).**

Regarding claims 15 and 64, it is noted that neither Williams, Cannon, Sklansky nor Moody teaches a gaming machine in which, when the bonus feature is triggered, an animation is displayed which indicates to the player which level of jackpot the player will win. However, Baerlocher suggests a gaming machine in which, when the bonus feature is triggered, an animation is displayed which indicates to the player which level of jackpot the player will win (¶ [0011]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams, Moody, Cannon, Sklansky and Baerlocher in order to create an interesting and exciting visual display.

***Response to Arguments***

**Applicant's arguments filed on 01/31/2011 have been fully considered but they are moot in view of the new grounds of rejection.**

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Rowland whose telephone number is (571) 270-7844. The examiner can normally be reached on Monday through Thursday, alternate Fridays, 8:30 am to 6:00 pm, Eastern Time. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Peter Vo can be reached at (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. R./
Examiner, Art Unit 3718

/Peter DungBa Vo/

Supervisory Patent Examiner, Art Unit 3718